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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 004770.00167

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Application Number	Filed
10/804,263	March 19, 2004
First Named Inventor	
Harri Pekonen	
Art Unit	**Examiner**
2617	Manoharan

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record. Registration number 51,393

☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

/William J. Allen/
Signature

William J. Allen
Typed or printed name

312-463-5000
Telephone number

February 2, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of one forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of Pekonen et al.	)	Art Unit: 2617
Application No. 10/804,263	)	Examiner: Manoharan, Muthuswamy Ganapathy
Filed: March 19, 2004	)	Confirmation No. 7432
For: Advanced Handover in Phased-Shifted and Time-Sliced Networks	)	Attorney Docket No. 004770.00167

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated in the below remarks. Applicants authorize the Commissioner to charge any necessary fees to Deposit Account No. 19-0733. Furthermore, if any additional fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

REMARKS/ARGUMENTS

Having received and reviewed the final Office Action dated November 2, 2006, Applicants respectfully submit that the outstanding rejections are based on one or more clear errors, and that the appeal process can be avoided through a pre-appeal brief review as set forth in the Official Gazette notice of July 12, 2005. Claims 1-27 are pending in this application.

There are four outstanding rejections in the instant application; claims 1, 5, 12, 20, 25 and 27 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Published Application No. 2003/0162543 to Auranen; claims 1-3, 5-6, 15-21, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Application No. 2003/0162535 to Nishiyama, in view of U.S. Patent No. 5,513,246 to Jonsson; claims 4, 7-13, 22-24, and 26-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Application No. 2003/0162535 to Nishiyama, in view of U.S. Patent No. 5,513,246 to Jonsson, and further in view of U.S. Patent No. 6,731,936 to Chen; and claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Application No. 2003/0162535 to Nishiyama, in view of U.S. Patent No. 5,513,246 to Jonsson, and further in view of U.S. Patent No. 6,366,568 to Bolgiano. For the details of this rejection refer to the Final Office Action mailed November 2, 2006, pages 4-16.

The specific error relied upon in this Pre-Appeal Brief Request for Review pertains to the Office Action's assertion that Auranen and Jonsson teach the claimed features of "performing the handover" in response to "receiving a final channel burst from the first base station" after "deciding to perform the handover to a selected candidate cell" as recited in independent claims 1, 20 and 27.

Additionally, the Office Action asserts that independent claim 25 "is rejected for the same reason as set forth in claim 1" even though a proper rejection was not provided for each of the features of claim 25 – the rejection merely stated that "**Claim 25** is rejected for the same reason as set forth in claim 1." However, the features of claim 25 vary in scope from those of claim 1. Furthermore, claim 1 is directed to a method while claim 25 is directed to a wireless terminal. Additionally, Applicants submit that neither Auranen nor Jonsson teach the some of the features of claim 25 for the same reasons that the references do not teach the features of independent claims 1, 20 and 27.

The final Office Action maintains the rejection of these features of independent claims 1, 20, 25, and 27 based on paragraphs 21-23 of Auranen and Col. 9, lines 60-67, Col. 10, lines 1-10 and 3-67 and Col. 11, lines 1-19 of Jonsson. As stated in Applicants' responses to previous Office Actions, Auranen deals generally with completing a handover between two cells entirely within the 39 seconds of downtime between two transmission bursts. The portion cited by the Office Action merely indicates that the mobile terminal in Auranen could perform the handover between the first and second bursts, or between the second and third bursts based on which transmission bursts have been input, but makes no mention of a transmission burst from the current cell after a handover decision is made. Auranen states "[w]hen a hand-over is required in the broadcasting system 30, the hand-over is performed only during one of these approximately 39-second time intervals which occur between transmission bursts of a selected service provider." (Paragraph 20). Paragraph 20 goes on to state that "[t]he disclosed system and method thus provide for an interrupt-free hand-over to be initiated and completed during a time interval in which no data transmission is expected from a selected service provider." The Office Action cites paragraph 22 of Auranen, specifically:

> "[i]f the predefined service signal criterion is met after the mobile terminal 39 has input the signal provided by the transmission burst 43a, for example, the change in frequency will preferably occur in the time interval between a termination point 51 of the transmission burst 43a (here shown at t=1 sec) and an initiation point 53 of the next transmission burst 45b (here shown at t=40 sec)...Alternatively, if the mobile terminal 39 had already input the transmission burst 45a, and the predefined criterion has been met, the change in frequency would instead occur between a termination point 55 of the transmission burst 45a and an initiation point 57 of the next transmission burst 47b (here shown at t=80 sec)."

Thus, paragraph 22 of Auranen clarifies that after a hand-over to a selected candidate cell is initiated and completed in the current time interval between bursts such that the next burst comes from the new transmitter of the selected candidate cell, and there is no final burst from the old transmitter or first base station. The claims of the present application are distinguishable in that once a determination to execute a handover has been made, the system forces receipt of one further transmission burst from the current base station before executing the handover and receiving the next burst from the new base station. This improvement over the prior art reduces the chance that a wireless terminal will miss a channel burst for the service. In the prior art, if a

determination is made to execute a handover in the time interval between bursts and "the wireless terminal does not complete the handover before channel burst 815 is transmitted, the wireless terminal will miss the next channel burst for the service, possibly causing degradation of the service." (Page 12, Lines 15-17 of Paragraph 41).

Jonsson generally discloses the use of different criteria for determining whether or not to perform a handover. Once again, Jonsson does not disclose or suggest "after performing (D), receiving a final channel burst from the first base station." In fact, Jonsson does not even contemplate the effects of executing a handover at different times; it merely looks to whether appropriate conditions exist to attempt a handover at all. The portion of Jonsson cited in the Office Action, Col. 9, lines 60-67, and Col. 10, lines 1-2, and lines 15-18 states:

> After the cell candidate list has been prepared, a check is made to assure that, if a handoff has been previously attempted but unsuccessfully, a specified minimum amount of time T_ALLOC_REP since the previous allocation failure of a channel in the handoff candidate cell has elapsed (S15). Insisting upon a waiting time until the next allocation attempt increases the likelihood of that allocation attempt being successful. If the required minimum amount of time has not expired, the locating routine returns to wait for the next appropriate evaluation time...
>
> If a channel cannot be allocated, an allocation failure time is set (S23) to ensure that the minimum specified amount of time will elapse before the next allocation attempt.

Thus, Jonsson does <u>not</u> teach "after performing (D), receiving a final channel burst from the first base station." As the cited paragraphs of Jonsson clearly show, a failed handover attempt and a forced wait time <u>must occur</u> before reevaluating whether another handover should be attempted. Nothing in Jonsson contemplates "receiving a final channel burst from the first base station" once a decision to handover is made and "performing the handover" "in response" to "receiving a final channel burst from the first base station." As can be seen from the language cited above, Jonsson merely contemplates "performing the handover" in response to the evaluation of certain handover criteria and the passing of a specified amount of time after a failed handover. Once again, nothing in Jonsson teaches, discloses or suggests the features as taught in the present application. For at least this reason, independent claims 1, 20, 25 and 27 are patentable over the proposed combination of Nishiyama and Jonsson, even if the proposed combination is deemed proper.

The remaining claims all depend, either directly or indirectly, from either independent claim 1, 20, or 25, and as such, are distinguishable for at least the same reasons as the claims from which they depend. For at least the above reasons, the pending claims are patentable over the §102(e) rejection based on Auranen and the §103(a) rejections, all of which are based on the proposed combination of Nishiyama and Jonsson.

Respectfully submitted,
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Dated: February 2, 2007

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